

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIHIKO TERADA, MASAYUKI SAITO,
TAKASHI TOYAMA, NORITADA NAGAO,
and MINORU FUJISAWA

Appeal No. 96-3726
Application 08/074,009¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH, and GARRIS, Administrative
Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed June 9, 1993. According to appellants, this application is a continuation of Application 07/747,477, filed August 13, 1991; which is a continuation of Application 07/399,567, filed August 23, 1989.

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This is a decision on an appeal from the final rejection of claims 1, 2, 10, 11 and 19 which are all of the claims remaining in the application.

The subject matter on appeal relates to a method of reforming a surface of a plastic article to provide a leather-like touch to the surface of the plastic article comprising coating the surface with a polyurethane paint made of polyester polyol and hexamethylene diisocyanate to thereby form a coated film having certain characteristics. Further details of this appealed subject matter are set forth in representative independent claim 1, a copy of which taken from the appellants' brief is appended to this decision.

The references relied upon by the examiner in the rejections before us are:

Wagner et al. (Wagner)	3,836,423	Sep. 17, 1974
Manabe et al. (Manabe)	4,551,387	Nov. 5, 1985

All of the appealed claims stand rejected under the first paragraph of 35 U.S.C. § 112 "as failing to provide an adequate written description of the invention" (answer, page 2 and page 3).

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Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by either Manabe or Wagner.

Claims 10 and 19 stand rejected under 35 U.S.C. § 102(b) or section 103 as being anticipated by or obvious over Wagner.

Finally, claim 11 stands rejected under 35 U.S.C. § 103 as being unpatentable over Wagner.

The claims on appeal have been separately grouped and argued in the manner set forth on page 4 of the brief.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and the examiner concerning the above noted rejections.

OPINION

We can not sustain any of the rejections advanced by the examiner on this appeal.

Concerning the section 112, first paragraph, rejection, the record before us reflects confusion on the examiner's part as to the distinction between the written description and the enablement requirements set forth in this paragraph. For example, while the examiner insists that his rejection is based upon the written description requirement, his rationale

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and criticisms concerning this rejection plainly relate to the enablement requirement. In any event, it is clear to us that the claims on appeal satisfy both the written description and enablement requirements for the reasons expressed by the appellants on pages 5 through 9 of the brief. It follows that we will not sustain the examiner's section 112, first paragraph, rejection of claims 1, 2, 10, 11 and 19.

As for the section 102 rejection based upon Manabe, it is the examiner's position that certain "limitations of the base claim, i.e. the paint forms a coated film having specific properties and the paint is a polyester system are non-patentable article limitations in a method claim" (answer, pages 3-4) and that such "limitations set forth above do not affect the [claimed] method in a manipulative sense and therefore cannot be held patentably limiting" (answer, page 4). The examiner is incorrect. The properties set forth in appealed claim 1 define the here claimed method whereby the desired leather-like touch is obtained, and all limitations must be accounted for in the prior art rejection under review. As argued by the appellants and impliedly acknowledged by the examiner, the disclosure of Manabe does not satisfy these

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property limitations, and accordingly the section 102(b) rejection of claims 1 and 2 over this reference also can not be sustained.

Wagner likewise fails to disclose at least some of the aforementioned properties of the independent claims on appeal. However, as an alternative to the unacceptable position that such properties are not "patentably limiting", the examiner urges that these properties are inherently possessed by patentee's polyurethane film and accordingly that Wagner anticipates the appellants' independent claims. This inherency position is based upon the fact that patentee's polyurethane film may be made from a polyester polyol and a diisocyanate such as n-hexyl diisocyanate and the fact that this polyurethane film is intended to provide the substrate (such as a plastic substrate) upon which it is placed with "the aesthetic appeal of leather" (column 1, line 21). As yet another alternative position under section 103 with respect to independent "arrangement" claims 10 and 19, the examiner contends that "it would have been obvious to optimize the physical properties of the Wagner . . . products to within the

instantly claimed ranges in order to maximize the leather-like touch desired by the patent" (answer, page 5).

It is important to here clarify that the Wagner patent contains no teaching of the desirability or mechanism for achieving a "leather-like touch" as the examiner seems to believe. Instead, as previously indicated, patentee teaches providing a substrate with "the aesthetic appeal of leather" via the use of a polyurethane film which exhibits permeability or "breathability" (e.g., see lines 8 through 24 in column 1 and lines 3 through 10 in column 2). The record presented to us by the examiner contains nothing to support a belief that Wagner's polyurethane film which possesses the characteristics of "breathability" and "the aesthetic appeal of leather" would necessarily and inherently also possess the characteristics of the "leather-like touch" and the properties recited in the independent claims on appeal. Stated otherwise, the examiner's implicit presumption that Wagner's film possesses the characteristic of a "leather-like touch" and thus inherently possesses the here claimed properties which produce this characteristic constitutes mere conjecture on the examiner's part. This is plainly inadequate to support the

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examiner's inherency position and the section 102 rejection based thereon as explained by the appellants in their brief (e.g., see pages 11-16).

The examiner's obviousness conclusion and the section 103 rejection based thereon are similarly defective. That is, even if the physical properties of Wagner's products were optimized as urged by the examiner, this optimization would have been made in order to achieve patentee's desired characteristics of "breathability" and "the aesthetic appeal of leather", and it would be pure conjecture to presume that optimized properties which yield such characteristics would be the same as or even overlap the properties which yield a "leather-like touch" in accordance with the appealed claims.

In light of the foregoing, we also can not sustain the examiner's section 102 and 103 rejections of the appealed claims over Wagner.

The decision of the examiner is reversed.

REVERSED

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	Edward C. Kimlin)	
	Administrative Patent Judge)	
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	John D. Smith)	BOARD OF
PATENT			
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	Bradley R. Garriss)	
	Administrative Patent Judge)	

tdc

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APPENDIX

բոլեաբէր բոլոյ ին միմիւս և Կանձէ քիւր քրօնք ի:Տ քօ Տ:Ի՝
քեմբէս քիւր իշօճԿԱՅԻՔԵ ձիօնք քիւր քիւր մլգքօղ ձիօնք իւ քիւր
Կանձիւն քիւր քօ քօ Տ00՝ մքեքիւ քիւր քօնիւրքիւրք մեքիւրք ԿԵՐԻՔ
քօքքքքքքք մեքիւրք Կանձիւն քիւր 1000 քօ 2000 քիւր ք մլգքօղ ԿԵՐԻՔ
քիւրքքքքքքք՝ քիւրք բոլեաբէր բոլոյ մԿԱԻՆ ք սիւքքք քԿԵԻՐԶԵ
բոլոյ քԿԵԻՔ իւքքքքքքք բոլեաբէր բոլոյ քիւր մեքքքքքքքքք
քիւրք քօ-իւքքքք բոլքքքքքքքք քիւրք քեքքք ք բոլեաբէր
Կանձիւն քիւր Տ0 քօ 120 քիւրքքքքքքքքք՝
քիւրքքքք քԿԵԻՐԶԵ քօ քօքք քիւրք քօքքքք քիւրք մԿԱԻՆ ք քիւրքքքքքք
քօքքքքք քիւրք բոլքքքքքքքք քիւրք քիւր քիւրքքք քօ քիւր
քԿԵԻՐԶԵ՝ քիւրք
քիւր քիւր իւքքքքք քօքքքքքք քօ քիւրքքքքքքքք Կանձիւն քիւր քօ 120
180% քԿ 50°C՝ ք քօքքքքքքքքք քօ քիւրքքքք Կանձիւն քիւր 0.2 քօ 0.8՝
ք քօքքքք քիւրք մԿԱԻՆ քիւր քօնքքքքքքք քեքքքքքքք Կանձիւն քիւր քօ քօ
քեքքքքքքք ք քօ-իւքքքք բոլքքքքքքքք քիւրք մքքքք քօքքք
քԿԵԻՐԶԵ՝ քօքքքքքքքքք:
քօ քօքքքքք ք քօքքքքք-իւքք քօքքք քօ քիւր քիւրքքք քօ քիւր քիւրքքք
Ի՝ ք քօքքքք քօ քօքքքքքքք ք քիւրքքք քօ ք քիւրքքքք քԿԵԻՐԶԵ